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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/753,118	01/07/2004	Timothy R. Littlefield	CTI-configur	5226

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PO BOX 3064
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EXAMINER

MARIAM, DANIEL G

ART UNIT	PAPER NUMBER
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2624

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/753,118

Applicant(s)

LITTLEFIELD ET AL.

Examiner

DANIEL G. MARIAM

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application
- ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 47-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 47 recites the limitation "said computer automatically providing cranial remodeling device information for use in fabricating a cranial remodeling device for said deformed head" in lines 8-9. However this limitation does not identify which one of the two data, i.e., first, second or both, utilized to the cranial remodeling device. Please clarify.

Since claims 48-55 directly or indirectly depend on claim 47, they are also rejected under 35 U.S.C. 112, second paragraph, for the same reason set forth above for claim 47.

Claim 48 recites the limitation "said configuration" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 3, 4, 8, 9, 28, 20, 21, 22, 26, 29, 30, 31, 32, 33, 34, 35, 36, and 37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1, 2, 3, 4, 6, 8, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, and 25 respectively of copending Application No. 11/584,334. The conflicting claims are not identical because copending application requires the additional step of “providing trim line information”, not required by claims 1, 28 and 29 of application ‘118. However, the conflicting claims are not patentably distinct from each other because:

- The claims recite common subject matter;
- Whereby claims 1, 28 and 29 of the ‘118 application, which recites the open ended transitional phrase “comprising”, does not preclude the additional elements recited by copending application claims 1, 12 and 17, and
- Whereby the elements of claims 1, 28 and 29 of the ‘118 application are fully anticipated by copending application ‘334 of claims 1, 12 and 17, and anticipation is “the ultimate or epitome of obviousness” (*In re Kalm*, 154 USPQ 10 (CCPA 1967), also *In re Dailey*, 178 USPQ 293 (CCPA 1973) and *In re Pearson*, 181 USPQ 641 (CCPA 1974)).

Claims 47 and 54 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12 and 16 respectively of

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copending Application No. 11/584,334. The conflicting claims are not identical because copending application claim 17 and 12 defines a method, while application claim 47 recites an “apparatus” corresponding to the method. However, the conflicting claims are not patentably distinct from each other because, given the considerable level of skill in the art of image/shape correction, one skilled in the art would have found it obvious to make and use an apparatus for performing the method defined by copending application claim 12.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claim 38 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 7,127,101. The conflicting claims are not identical because patent claim 5 requires the additional element of “providing trim line information”, not required by claim 38. However, the conflicting claims are not patentably distinct from each other because:

- Claims 38 and 5 recite common subject matter;
- Whereby claim 38, which recites the open ended transitional phrase “comprising”, does not preclude the additional elements recited by claim 5, and
- Whereby the elements of claim 38 are fully anticipated by patent claim 5, and anticipation is “the ultimate or epitome of obviousness” (*In re Kalm*, 154 USPQ 10 (CCPA 1967), also *In re Dailey*, 178 USPQ 293 (CCPA 1973) and *In re Pearson*, 181 USPQ 641 (CCPA 1974)).

Claim 10 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 7,127,101. The

conflicting claims are not identical because patent claim 5 defines an apparatus, while claim 10 of the application defines a method corresponding to the steps performed by the apparatus.

However, the conflicting claims are not patentably distinct from each other because claims 10 and 5 recite common subject matter; whereby claim 10, which recites the open ended transitional phrase “comprising”, does not preclude the method as being performed by an apparatus, and whereby the elements of claim 10 are fully anticipated by patent claim 5, and anticipation is “the ultimate or epitome of obviousness” (*In re Kalm*, 154 USPQ 10 (CCPA 1967), also *In re Dailey*, 178 USPQ 293 (CCPA 1973). and *In re Pearson*, 181 USPQ 641 (CCPA 1974)).

Conclusion


5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent Numbers: 5094229, 5331550, 5951503, 6340353, 6423019, 6536058 and 6572572.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL G. MARIAM whose telephone number is 571-272-7394. The examiner can normally be reached on M-F (7:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MATTHEW BELLA can be reached on 571-272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


DANIEL G MARIAM
Primary Examiner
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March 30, 2007